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Paper No. 15

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**JUN 24 2004**

**OFFICE OF PETITIONS**

In re Application of :  
Richard Naimish : DECISION ON PETITION  
Application No. 09/765,174 :  
Filed: January 18, 2001 :  
Attorney Docket No. Roh-N :

This is a decision on the "REQUEST TO RECONSIDER DENIAL OF PETITION TO WITHDRAW HOLDING OF ABANDONMENT," filed June 15, 2004.

The petition is GRANTED.

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed November 20, 2002. This Office action set a three-month shortened statutory period for reply, with extensions of time obtainable under § 1.136(a) or (b). No reply having been received, the above-identified application became abandoned on February 21, 2003. A Notice of Abandonment was mailed on December 17, 2003.

An initial petition under § 1.137(a) was filed on March 1, 2004. By decision mailed March 9, 2004, the petition was dismissed. A petition to withdraw holding of abandonment was filed on March 29, 2004. By decision mailed May 21, 2004, the petition was denied. Petitioner failed to establish by virtue of compliance with 37 C.F.R. § 1.8 or § 1.10, or by virtue of *prima facie* evidence in the form of an itemized and date-stamped postcard that the amendment was timely filed. The requirements of § 1.10 were at issue because on petition under § 1.137(a), applicant proffered an "Express Mail Post Office to Addressee" label (and other evidence relative to a showing under § 1.10) to establish timely filing. However, petitioner did not meet the requirements of § 1.10<sup>1</sup>. The issue was further confused by petitioner

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<sup>1</sup> § 1.10 (e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the

submitting a copy of the amendment, which admittedly unlike the original met the requirements of § 1.10. Specifically, it included the Express Mail mailing label number. It was then unclear as to what other extent the copy was unlike the original.

37 C.F.R. § 1.8 and postcard evidence were at issue because those are the other means by which an applicant can establish timely filing. However, petitioner also did not meet the requirements of § 1.8(b)<sup>2</sup> to show that the amendment should be considered

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Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

However, see also MPEP 513. 37 CFR 1.10(e) applies only in those situations in which the correspondence at issue was lost in toto (i.e., the entire correspondence was not delivered to the Office). Where there is a dispute as to the contents of correspondence submitted to the Office (e.g., an applicant asserts that three sheets of drawings were submitted under 37 CFR 1.10 with an application, but the Office records indicate receipt of only two sheets of drawings with the application), an applicant may not rely upon the provisions of 37 CFR 1.10(e) to establish what document(s) and/or fee(s) were filed in the Office with such correspondence. Rather, where the records of the Office (e.g., the file of the application) contain any document(s) or fee(s) corresponding to the contents of the correspondence at issue, the Office will rely upon its official record of the contents of such correspondence in absence of convincing evidence (e.g., a postcard receipt under MPEP § 503 containing specific itemization of the document(s) or fee(s) purported to have been filed with the correspondence at issue) that the Office received and misplaced any document(s) or fee(s) that is not among the official records of the Office.

<sup>2</sup> 37 CFR § 1.8 (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed,

timely filed. Moreover, petitioner argued that the amendment was among the papers received in the Office on February 14, 2003, but did not provide an itemized and date-stamped return postcard receipt to establish that the amendment was among the items received in the Office on February 14, 2003. On these bases, the prior petitions were properly dismissed or denied. (Petitioner should have properly filed the initial petition under § 1.181 as a petition to withdraw the holding of abandonment on the basis that the amendment should be considered timely filed pursuant to § 1.8(b), and included the showing under § 1.8(b) on petition under § 1.181. The petition under § 1.137(a) could have been included as an alternative basis for relief if the petition under § 1.181 failed).

Nonetheless, on instant request for reconsideration, petitioner has provided additional clarification regarding the nature of the copy of response submitted. In addition, petitioner has submitted a statement attesting on a personal knowledge basis to the previous timely mailing of the response. Accordingly, it is concluded that the amendment should be considered timely filed pursuant to 37 C.F.R. § 1.8(b).

In view thereof, the holding of abandonment is hereby withdrawn.

The application is being forwarded to Technology Center 2837 for consideration of the amendment submitted on petition March 1, 2004 (Paper No. 9).

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

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terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence: (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence; (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.